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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,525	05/23/2001	Tadashi Goino	2842.04US01	3075

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 Douglas J. Christensen, Esq.
 Patterson, Thunte, Skaar & Christensen, P.A.
 4800 IDS Center
 80 South Eighth Street
 Minneapolis, MN 55402-2100

EXAMINER

ZURITA, JAMES H

ART UNIT

PAPER NUMBER

3625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/864,525

Applicant(s)

GOINO, TADASHI

Examiner

James H. Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-16,43,51,93-97,103-116 and 119-121 is/are pending in the application.
- 4a) Of the above claim(s) 4-7,10-16,43,51,93-97,103-116 and 119-121 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 8, 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's amendment of 26 December 2006 has been entered.

Claims 3, 17-42, 44-50, 52-92, 98-102, 117 and 118 are cancelled.

Claims 1-2, 4-16, 43, 51, 93-97, 103-116, 119-121 are pending.

Of these pending claims, Claims 4-7, 10-16, 43, 51, 93-97, 103-116 and 119-121 are withdrawn from prosecution as being directed to a non-elected invention.

Applicant amended claims 1, 2, 8 and 9.

Response to Arguments

Applicant's comments concerning the Information Disclosure Statements are noted.

Applicant's arguments filed 26 December 2006 have been fully considered but they are not persuasive.

Applicant argues,

Amended claim 1 recites "an auction element other than a price," which is used in the bidding step, and amended claim 2 now recites "attribute information to identify the article or the service offered for bidding." Applicant respectfully submits that an auction element (other than a price) used in bidding is distinct from, and therefore does not contradict, attribute information intended to identify an article or service.

Similarly, the "trade conditions" recited in each of amended claims 8 and 9 do not contradict the auction element recited in amended claim 1. Collection information as recited in the claims can include both an auction element and trade conditions.

Applicant's remarks fail to clarify the metes and bounds of the claims. The claims are directed to transmitting various sets of information over a network.

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Giving the terms of the claims their broadest reasonable interpretation, *collection [first] information* may include price, as well as auction elements other than a price. See Figs. 2-4, for example. The same is true also for *attribute [second] information* and *desired trade conditions [third information]*.

Applicant argues:

Wellman does not mention a potential bidder providing reference information for locating an article or service offered for bidding. FIG. 2 of Wellman is a seller input screen; see Wellman at col. 3, lines 9-11.

In FIG. 3 of Wellman, which is a buyer input screen, a buyer "may specify a set of exclusive multi-attribute bids" (Wellman, col. 5, lines 42-49; emphasis added), not provide reference information for locating an article or service offered for bidding.

Wellman further provides that the input screen 300 represents a "set of bids." (Wellman, col. 6, lines 19-23.) Again, the information provided is a multi-attribute bid (Wellman, col. 6, lines 2-6), nor reference information for locating an article or service as in amended claim 1.

The Examiner respectfully disagrees. Seller and buyer attributes are matched, as in Fig. 5A, step 506. Matching is possible because the system collects information, as in step 502, i.e., ***bidders provide reference information*** for locating an article or service offered.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 2, 8 and 9, it is not possible to reliably and patently distinguish differences of ***element v. attribute v. trade conditions*** and their equivalents in order to avoid infringement. Again, the Examiner notes that the various labels (*element, attribute, trade condition*) do not appear to provide patentable distinction and are given little or no patentable weight. The terms will be interpreted as referring to overlapping sets of information related to auction items.

- Auction element other than price, non-price elements. Bid information may include both auction elements other than price as well as auction element price
- attributes can be price and non-price information
- trade conditions can be price and non-price information

In claim 1, the limitation “***...auction element other than price...***” remains indefinite and it is not possible to determine the metes and bounds of the claims.

In claims 1 and 2, the term “***...or...***” continues to render the claims indefinite, since it is not possible to determine the scope of the claim as requiring both items or only one of the items separated by the ***or***. For purposes of this examination, examiner will give the term its broadest reasonable interpretation and consider that the particular condition is satisfied if one of the limitations is met.

In claim 2, “***...attribute information...***” remains indefinite, since it is not possible to determine the difference between an ***element v. attribute***.

In claims 8 and 9, the term “***...trade conditions...***” remains indefinite. The term appears to refer to trading due date condition (Abstract), trade period conditions [paragraph 0120], favorable conditions for the client [paragraph 0126], trading conditions on time slide scheme and price slide setting type [paragraph 0131], trading conditions such as bid information, bidder offer conditions [paragraph 0135], bidder

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offered conditions (**price**, article delivery date and so on) of [paragraph 0151]. Several of these items overlap and contradict what applicant refers to as **attributes** and **elements**.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1, interpreted in light of rejections under 35 USC 112, is rejected under 35 U.S.C. 102(e) as being anticipated by Wellman (US 6,952,682).

Prior art will be interpreted to read on applicant's elements, attributes and trade conditions where prior art discloses any non-price dimension/characteristic/basis for evaluation.

As per claim 1, Wellman discloses methods of conducting an auction for bidding on an article or a service through a network, said method comprising:
a collection step including

- providing, by a potential bidder through an auction intermediary server, reference information for locating an article or a service offered for bidding (See, for example, at least Fig.5A, step 502, where the bidders submit offers that identify and locate desired items;
- transmitting collection information for located articles or services offered for bidding (the information is transmitted from potential buyers, i.e., bidders) and matching (Fig. 5A, step 506) the reference information to terminals through the

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network to collect bids, wherein the collection information includes an auction element other than a price (assigned attributes and best match, Fig. 5A);

a bidding step including

- receiving, by the server through the network, bid information communicated by terminals of potential bidders (Fig. 3, buyers) , wherein the bid information includes a bid based on the auction element see Fig. 3, input screen, including field(s) for entry of non-price elements; and

a bid acceptance step (collect offers from buyers and sellers, Fig. 5A, item 502)

including

- processing, by the server, the bid information to determine a result of the bidding step based on the bid information (step 506, Fig. 5A) and
- selecting a successful bidder (as in Fig. 7, step 710 and related text).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 8, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wellamn, above.

As per claim 2, Wellman discloses

- making a request by a seller to offer the article or the service for bidding (as in Fig. 2, entering specified fields);
- a seller providing attribute information to identify the article or the service offered for bidding (see Fig. 2 and related text);
- receiving the request and the attribute information by the server from the terminal of the seller via the network (see at least Fig. 1 and related text).

As per claim 8 (as interpreted), Wellman discloses that the server
Prompting the seller, via the client to offer desired trade conditions (see, for example, references to desired delivery time, as in Col. 5, lines 33-40)

Receiving the request information including the desired trade conditions (the information is sent from the client to the server, and is used by the server in determining matches, screens 200 and 300);

Transmitting the desired trade condition as information used as a reference in conducting a bid to the terminal of a bidder to present the desired trade conditions to the bidder (see at least Fig. 8 and related text, for example); and

Executing the bid processing with the non-price element in accordance with the desired trade conditions based on the bid information (see Fig. 7 and related text).

As per claim 9 (as interpreted), Wellman discloses that the server
Having a seller, by the server on a request screen, provide the desired trade conditions (see, for example, references to desired delivery time, as in Col. 5, lines 33-40); and

presenting the desired trade conditions on the bid screen (see, for example, at least Fig. 8 and 9 and related text).

As per claims 2, 8 and 9 Wellman does not specifically disclose **prompting** the seller. Wellman suggests that the actual screen may be in other configuration and format. It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Wellman to include prompting a seller, by the server through a terminal of the seller, to provide attribute information to identify the article or the service offered for bidding.

One of ordinary skill in the art at the time the invention was made would have been motivated to extend Wellman to include prompting a seller, by the server through a terminal of the seller, to provide attribute information to identify the article or the service offered for bidding for the obvious reason that prompting a person to fill specific fields reduces the amount of errors.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Zurita
Primary Examiner
Art Unit 3625
10 April 2007


JAMES ZURITA
PRIMARY EXAMINER